

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. COMROE, ROBERT W. FURTAW
ARUN SOBTI and JOHN E. MAJOR

Appeal No. 96-1386
Application 08/030,937¹

ON BRIEF

Before HAIRSTON, KRASS and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

As originally filed, this patent application contained 19 claims. Claims 15 and 16 were allowed in the examiner's rejection (Paper No. 8) dated May 25, 1994. Claims 13 and 14 were canceled by appellant in a § 116 amendment (Paper no. 13½)

¹Application for patent filed March 12, 1993.

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dated May 3, 1995. Claim 12 was allowed in the Examiner's Answer (Paper no. 20) dated September 21, 1995. Therefore, claims 1 through 11 and 17 through 19 are properly before us for our consideration.

The invention relates to land mobile dispatch radio communication systems. In particular, Appellants disclose on pages 1 and 2 of the specification that unlike radio telephony systems, where a user establishes contact with another party by inputting a unique ID code, a telephone number, dispatch radios are pre-programmed to automatically identify their transmissions as being intended for reception by members of a particular pre-identified fleet. The user need only actuate a push-to-talk (PTT) switch on the radio and begin speaking. Appellants further disclose on pages 2 and 3 of the specification that video transmission systems using land mobile dispatch radio units are known. However, Appellants point out that as of the date of the filing of the application, a land mobile dispatch radio used as a video modem is dedicated to this service and precludes the radio's primary function of providing voice communications. Appellants disclose that the problem that they solved is integrating total communications capabilities including audio,

video imaging and imaging display capabilities into a single land

mobile dispatch radio system that will not substantially distract from the portability or utility of the communication unit while maintaining compatibility with existing land mobile dispatch radio channels.

On pages 4 through 7 of the specification, Appellants disclose a block diagram of a two-way dispatch radio communication unit in accordance with the invention which is illustrated in Figure 4. In particular, a radio transceiver for transceiving dispatch communication is shown as element 408. A microphone 416 is coupled to the radio transceiver 408 for providing audible messages to the radio transceiver 408 for transmission. A video input system including an image sensor 108 and image memory 412 is coupled to the radio transceiver 408 for providing video information to the radio transceiver 408 for transmission. A control logic system 404 is coupled to the radio transceiver 408 for controlling operation of the radio transceiver 408 in two modes of operation. In the first mode, the radio transceiver 408 transmits audible messages. In the second mode, the radio transceiver 408 transmits video information. Appellants further

disclose that a push-to-talk switch 106 is coupled to the control logic system 404 for selecting the two modes of operations.

The independent claim 1 is reproduced as follows:

1. A two-way dispatch radio communication unit, comprising:

A) radio transceiver means for transceiving dispatch communications;

B) microphone means operably coupled to the radio transceiver means for providing audible messages to the radio transceiver means to allow transmission of the audible messages;

C) video input means operably coupled to the radio transceiver means for providing video information to the radio transceiver means to allow transmission of the video information;

D) control means operably coupled to the radio transceiver means, for controlling operation of the radio transceiver means in at least a first and second discrete mode of operation, wherein:

i) in the first discrete mode of operation, the radio transceiver means transmits the audible messages;
and

ii) in the second discrete mode of operation, the radio transceiver means transmits the video information;

E) push-to-talk switch means operably coupled to the control means, for selecting the first and second discrete modes of operation.

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The Examiner relies on the following references:

Brown	4,317,130	Feb. 23, 1982
Shimoda et al. (Shimoda)	4,985,755	Jan. 15, 1991

Claims 1 through 11 and 17 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Shimoda.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 11 and 17 through 19 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance***

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Mfg. v. SGS Importers Int'l, Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 117 S.Ct. 80 (1996) **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

The Examiner argues on page 5 of the answer that Brown inherently teaches a radio dispatch communication unit capable of audible transmission via a microphone means. The Examiner argues that Brown discloses a typical and standard radio dispatch communication unit and directs us to review column 2, lines 26-30 and column 3, lines 53 and 54 of Brown. The Examiner reasons that all typical and standard radio dispatch communication units have a microphone means coupled to the transceiver for transmission of audio only mode. The Examiner concludes that it would have been obvious to one skilled in the art to modify the Brown video only mode radio dispatch communication unit to provide an audible mode integrally housed together in the same unit with the video transmission communication unit.

Appellants argue on pages 5 through 8 of the brief that Brown and Shimoda fail to teach or suggest a microphone or a

control means which provides a first discrete mode of operation which transmits audible messages. Appellants agree that Brown discusses a push-to-talk switch but argues that the teaching does not suggest a microphone or a control means to provide a first discrete mode of operation that transmits audible messages in

which the first mode of operation is discrete from the second mode of operation that transmits video information as recited in Appellants' claims. Appellants provide an affidavit in which Daniel P. Brown, the inventor of the Brown patent, states that the Brown patent does not contain a teaching of a microphone to be included with the radio 22. Mr. Brown also states that the push-to-talk switch is triggered electronically and is not triggered by a switch in a microphone as done in the typical communication units. Appellants also provide an affidavit in which Gary Grube states that the Brown patent teaches a way to use a typical and standard two-way FM radio to transmit video data, as versus voice. Mr. Grube states that the Brown patent teaches that the push-to-talk switch is selectively enabled so that the data is ready and available for transmission.

In our own careful review of Brown, we find that Brown does

not teach or suggest a two-way dispatch radio communication unit having a microphone and a control means for controlling operation of the radio transceiver means in at least a first and second discrete mode, wherein in the first discrete mode, the radio transceiver means transmits audio messages and in the second

mode, the radio transceiver means transmits the video information and the push-to-talk switch means for selecting the first and second discrete modes of operation as recited in Appellants claims. Brown teaches to those skilled in the art how to modify a typical two-way dispatch radio communication unit to become a dedicated two-way dispatch radio communication unit that only has one mode in which video information is transmitted. See columns 1 and 2. Brown does not teach a modification in which typical two-way dispatch radio communication retains its original function of having a discrete mode for transmitting audible messages. We agree that Brown does mention a push-to-talk switch of a typical two-way dispatch radio in column 5, lines 52 and 53. However, in column 5, lines 35-68, Brown teaches that the push-to-talk switch is modified so that the PIA 34 keys the

transmitter portion of FM radio 22 to a transmit condition, as by controlling the push-to-talk microphone switch of a typical FM radio. Thus, we fail to find that Brown teaches or suggests an apparatus or method of transmitting audio and video information in which audio information is transmitted as input through a microphone when the push-to-talk switch is asserted in a first

manner and video information is transmitted as input through a video input device when the push-to-talk switch has been asserted in a second manner. Furthermore, we find that Shimoda fails to supply this missing teaching.

In addition, the Examiner has to provide more evidence than simply establishing that the Brown system could be modified to obtain Appellants' invention. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The Examiner has not provided any evidence in the prior art that

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would have led those skilled in the art to make the Examiner's proposed modification. Therefore, we find that the Examiner has failed to establish that the prior art would have taught or suggested to those skilled in the art to modify Brown's communication unit having one mode of operation of transmitting video information to a communication unit having both a audible mode

of operation and a video mode of operation as recited in the Appellants' claims by pointing to the express teachings or suggestions found in the prior art.

We have not sustained the rejection of claims 1 through 11 and 17 through 19 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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Administrative Patent Judge)

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